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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,594	11/20/2003	Gert Johannes Brits	034896-0107	7212
7590 03/19/2004				
Foley & Lardner Suite 500 3000 K Street, N.W. Washington, DC 20007-5109			EXAMINER HWU, JUNE	
			ART UNIT 1661	PAPER NUMBER

DATE MAILED: 03/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/716,594

Applicant(s)

BRITS, GERT JOHANNES

Examiner

June Hwu

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### **Drawings**

An Official Draftsman has approved the drawings.

### **Objection to the Disclosure**

#### **37 CFR 1.163**

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

#### **35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

In plant application filed under 35 U.S.C. 161, the requirements of 35 U.S.C. 112 are limited.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164

(reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

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In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 37 CFR 1.163(a) because the specification presents less than a full and complete botanical description and the characteristics which distinguish over related known varieties.

More specifically:

- A. On page 1, line 3, the species name of the claimed plant as "*hybridus*" may be misspelled and should be changed to read -- *hybrida* --. Correction is necessary.
- B. On page 1, line 12, Applicant should import into the specification the application serial number -- 10/716,659 -- for 'Cape Angels Pink'.
- C. On page 1, line 15, the recitation "blue market cultivar" is unclear. Clarification is necessary.
- D. Applicant is requested to recite whether the cultivar Edelbau has been patented in the United States, is currently the subject of a pending U.S. plant patent application, or non-patented. If patented, -- U.S. Plant Patent No. -- should be inserted after the cultivar name. If the cultivar is subject of a pending application, such should be referred to by serial number. If non-patented, -- non-patented -- should be inserted after the cultivar name.

E. On page 1, lines 10-19 through page 2, lines 1-4, there is a discrepancy on the origin of the claimed plant. On page 1, line 11, applicant states that the claimed plant is a "mutation (sport)" and then on page 1, lines 16-19, Applicant states, "The new *Plectranthus* originated from a hybrid backcross..." between two proprietary lines. This is confusing because it is uncertain whether the claimed plant is a sport mutation or a hybrid backcross. Clarification and correction are necessary.

F. On page 1, line 17 and page 4, line 15, the recitation "hybrid backcross" is unclear because if it is a backcross, Applicant must state which parent is used in the backcross. Clarification and correction are necessary.

G. On page 2, lines 2-4, Applicant states that the new cultivar was selected from a cross but on page 1, line 11; Applicant states the new cultivar was from a sport mutation. Clarification is necessary.

H. On page 3, line 6, the recitation "Shorter production time" is vague because there is no comparison to how short is the production time and of what. Clarification is necessary.

I. Applicant must set forth in the specification a brief description how the new variety is distinguished from any similar related cultivars.

J. On page 5, line 15, a definition is needed for the term "brochididromus" because it does not exist in the dictionary.

K. Applicant should set forth in the specification the average diameter of the petiole.

L. Page 6, lines 3-4, the recitation "Longevity of individual flowers is highly dependent on temperature and light conditions" does not sufficiently describe the lastingness of the blooms. Applicant should import into the specification the average lastingness of the blooms at a given location of culture.

M. Applicant should set forth in the specification the average length of the inflorescence.

N. Applicant should set forth in the specification the average size of the individual flower or floret.

O. Applicant should set forth in the specification the average size (length and diameter) of the floral tube.

P. On page 6, line 13, the recitation "white" is vague and does not sufficiently describe the color designation with reference to an employed color chart of the flower bud. Clarification is necessary.

Q. Applicant should set forth in the specification the sepals' average size and surface texture.

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- R. Applicant should set forth in the specification the pedicel's and peduncle's average length, diameter, surface texture and color designation with reference to an employed color chart.
- S. Applicant should set forth in the specification the average lengths of the stamens and anthers. Additionally, Applicant should set forth in the specification the average length and color designation with reference to an employed color chart of the filaments.
- T. Applicant should set forth in the specification the pistil's number.
- U. Applicant should set forth in the specification a botanical description of the capsule's size, surface texture, and color designation with reference to an employed color chart.
- V. On page 7, line 11, the recitation "5C" is unclear because the term degrees or its symbol is missing.

The above listing may not be complete. Applicants should carefully compare the claimed plant with the botanical descriptions set forth in the specification to ensure completeness and accuracy and to distinguish the plant within this expanding market class. Any further botanical information should be imported into the specification, as should any additional or corrected information relative to same.

### **Claim Rejection**

**35 USC § 112, 1st and 2nd Paragraphs**

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Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for reasons set forth in the Objection to the Disclosure Section above.

### **Future Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to June Hwu whose telephone number is (571) 272-0977. The Examiner can normally be reached Monday through Thursday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (571) 272-0974. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

JH

  
ANNE MARIE GRUNBERG  
PRIMARY EXAMINER